

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed March 14, 2005. Through this response, claims 1, 10-13, and 19-22 have been amended. Reconsideration and allowance of the application and pending claims 1-22 are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 102(e)

A. Statement of the Rejection

Claims 1, 2, 4-8, 10, 11, 13, 14 and 16-19 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by *Chu* ("Chu," U.S. Pat. No. 6,703,550). Applicant respectfully traverses this rejection.

B. Discussion of the Rejection

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the *Chu* reference.

Independent Claim 1

Claim 1 recites the following (emphasis added):

1. A method for ***operating a measurement and testing instrument configured to measure a characteristic of a device-under-test***, the method comprising the steps of:

receiving a first user input provided via a first component of a pointing device;

moving a cursor displayed on a display device responsive to the first user input;

receiving a second user input provided by rotating a second component of the pointing device; and

modifying an item displayed on the display device responsive to the second user input and responsive to where the cursor is located when the second user input is received, *the item corresponding to a measurable characteristic of the device-under-test*.

Applicant respectfully submits that *Chu* does not disclose at least the emphasized claim features. *Chu* appears to disclose a haptic feedback interface device that is used in cooperation with a host computer. (see col. 3, lines 32-38) There is no device-under-test (DUT) disclosed from which characteristics of the DUT are monitored or measured. In contrast, sound data stored in memory is manipulated. (see col. 1, lines 1-59 and col. 3, lines 32-38, and Figure 2)

Additionally, selection appears to be performed through a push/pull mechanism post-knob rotation that moves a cursor. (see col. 8, lines 25-33) Assuming the Office Action is equating the first component to a knob rotation and the second component to a push/pull action, these operations are not the same as “receiving a second user input provided by *rotating* a second component of the pointing device cursor movement on a display device, and *modifying an item* displayed on the display device responsive to the second user input and responsive to where the cursor is located when the second user input is received, *the item corresponding to a measurable characteristic of the device-under-test*,” as recited in independent claim 1. Because *Chu* does not disclose all of the claimed features, independent claim 1 is patentable over *Chu*, and thus Applicant respectfully requests that the rejection be withdrawn.

Because independent claim 1 is allowable over *Chu*, dependent claims 2-9 are allowable as a matter of law for at least the reason that the dependent claims 2-9 contain

all elements of their respective base claim. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Independent Claim 10

Claim 10 recites the following (emphasis added):

10. A measurement and testing system comprising:
an input-execution module for modifying an item displayed on a display device responsive to a second user input provided by rotating a second component of a pointing device, the item corresponding to a measurable characteristic of a device-under-test; and
an input-dispatch module for passing the second user input to the input-execution module responsive to a cursor being displayed at a location corresponding to the input-execution module, wherein a location of the cursor is responsive to a first user input provided by a first component of the pointing device.

Applicant respectfully submits that *Chu* does not disclose at least the emphasized claim features. *Chu* appears to disclose a haptic feedback interface device that is used in cooperation with a host computer. (see col. 3, lines 32-38) There is no device-under-test (DUT) disclosed from which characteristics of the DUT are monitored or measured. In contrast, sound data stored in memory is manipulated. (see col. 1, lines 1-59 and col. 3, lines 32-38, and Figure 2)

Additionally, selection appears to be performed through a push/pull mechanism post-knob rotation that moves a cursor. (see col. 8, lines 25-33) Assuming the Office Action is equating the first component to a knob rotation and the second component to a push/pull action, these operations are not the same as “an input-execution module for modifying an item displayed on a display device responsive to a second user input provided by *rotating a second component* of a pointing device, the item corresponding to a measurable characteristic of a device-under-test,” as recited in independent claim 10. Because *Chu* does not disclose all of the claimed features,

independent claim 10 is patentable over *Chu*, and thus Applicant respectfully requests that the rejection be withdrawn.

Because independent claim 10 is allowable over *Chu*, dependent claims 11-13 are allowable as a matter of law.

Independent Claim 14

Claim 14 recites the following (emphasis added):

14. A method for operating a measurement and testing instrument configured *to measure a characteristic of a device-under-test*, the method comprising the steps of:
receiving a first user input provided via a first component of a pointing device;
moving a cursor displayed on a display device responsive to the first user input;
receiving a second user input provided by rotating a second component of the pointing device;
identifying a module that corresponds to a current location of the cursor;
providing the second user input to the module; and
performing by the module an action that is specified by the user input.

Applicant respectfully submits that *Chu* does not disclose at least the emphasized claim features. *Chu* appears to disclose a haptic feedback interface device that is used in cooperation with a host computer. (see col. 3, lines 32-38) There is no device-under-test (DUT) disclosed from which characteristics of the DUT are monitored or measured. In contrast, sound data stored in memory is manipulated. (see col. 1, lines 1-59 and col. 3, lines 32-38, and Figure 2)

Additionally, *Chu* fails to disclose the feature of “identifying a module that corresponds to a current location of the cursor,” as recited in independent claim 14. It is not clear from the Office Action that these explicit claim features were addressed, as required under MPEP 707.07. Thus, in the next Office Action, Applicant respectfully requests clarification as to where these features are allegedly present in

Chu to give Applicant a reasonable opportunity to address the rejection. Because *Chu* does not disclose all of the claimed features, independent claim 14 is patentable over *Chu*, and thus Applicant respectfully requests that the rejection be withdrawn.

Because independent claim 14 is allowable over *Chu*, dependent claims 15-18 are allowable as a matter of law.

Independent Claim 19

Claim 19 recites the following (emphasis added):

19. A measurement and testing system comprising:
means for receiving a first user input provided via a first component of a pointing device and ***a second user input provided by rotating a second component of the pointing device;***
means for moving a cursor displayed on a display device responsive to the first user input;
means for modifying an item displayed on the display device responsive to the second user input and responsive to where the cursor is located when the second user input is received, the item corresponding to a measurable characteristic of a device-under-test.

Applicant respectfully submits that *Chu* does not disclose at least the emphasized claim features. *Chu* appears to disclose a haptic feedback interface device that is used in cooperation with a host computer. (see col. 3, lines 32-38) There is no device-under-test (DUT) disclosed from which characteristics of the DUT are monitored or measured. In contrast, sound data stored in memory is manipulated. (see col. 1, lines 1-59 and col. 3, lines 32-38, and Figure 2)

Additionally, selection appears to be performed through a push/pull mechanism post-knob rotation that moves a cursor. (see col. 8, lines 25-33) Assuming the Office Action is equating the first component to a knob rotation and the second component to a push/pull action, these operations are not the same as “a second user input provided by ***rotating a second component*** of the pointing device” and “means for modifying an item displayed on the display device ***responsive to the second user input*** and

responsive to where the cursor is located when the second user input is received,” as recited in independent claim 19. Because *Chu* does not disclose all of the claimed features, independent claim 19 is patentable over *Chu*, and thus Applicant respectfully requests that the rejection be withdrawn.

Because independent claim 19 is allowable over *Chu*, dependent claims 20-22 are allowable as a matter of law.

Due to the shortcomings of the *Chu* reference described in the foregoing, Applicant respectfully asserts that *Chu* does not anticipate Applicant’s claims. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

II. Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims 3, 12, 15 and 20 and 9 and 22

Claims 3, 12, 15 and 20 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Chu* in view of *Mader et al.* (“*Mader*,” U.S. Pat. No. 5,129,722). Claims 9 and 22 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Chu* in view of *Hinckley et al.* (“*Hinckley*,” U.S. Pub. No. 2002/0118168). Applicant respectfully traverses these rejections.

B. Discussion of the Rejection

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d

1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, Applicant respectfully submits that a *prima facie* case of obviousness has not been established. As explained above, Applicant respectfully submits that *Chu* fails to disclose at least the emphasized claim features of independent claims 1, 10, 14, and 19. Neither *Mader* nor *Hinckley* remedy the deficiencies of *Chu*. Thus, because dependent claims 2-9, 11-13, 15-18, and 20-22 contain the features of their respective base claim, dependent claims 2-9, 11-13, 15-18, and 20-22 are allowable over the cited references.

Additionally, Applicant respectfully submits that the proposed combination of *Chu* and *Mader* is improper. It has been well established that teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, there must be a teaching in the relevant art which would suggest to a person having ordinary skill in that art the desirability of combining a computer with a measurement device that measures and manipulates device-under-test characteristics with a user pointing device having the above-recited claim features. *Chu* discloses a host computer and haptic input device, without any suggestion or

disclosure of such a system used in the measurement of data from a device-under-test. *Mader*, on the other hand, discloses an oscilloscope without any recitation of a pointing device as claimed.

In summary, it is Applicant's position that a *prima facie* for obviousness has not been made against Applicant's claims. Therefore, it is respectfully submitted that each of these claims is patentable over the proposed combination of references and that the rejection of these claims should be withdrawn.

CONCLUSION

Applicants respectfully submit that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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